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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/418,932	10/15/1999	TAKAMOTO IMATAKI	0941.63354	9496

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GREER, BURNS & CRAIN  
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CHICAGO, IL 60606

EXAMINER
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BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 07/20/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/418,932

Applicant(s)

IMATAKI, TAKAMOTO

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications: amendment and RCE filed 5/6/2004, to the original application filed 10/15/1999, with foreign priority filing date of 10/20/1998. IDS filed 10/30/2000 (paper 3), 9/23/2002 (paper 6), and 8/14/2003 (paper9).
2. The rejection of claims 1-3, 6, 8-10 under 35 U.S.C. 103(a) as being unpatentable over Halliday and Mellgren, has been withdrawn as necessitated by amendment.
3. The rejection of claims 4-5 under 35 U.S.C. 103(a) as being unpatentable over Halliday, Mellgren, and Bretschneider, has been withdrawn as necessitated by amendment.
4. The rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Halliday and Mellgren has been withdrawn as necessitated by amendment.
5. The rejection of claims 11-19 under 35 U.S.C. 103(a) as being unpatentable over Halliday, Mellgren, and Bretschneider, has been withdrawn as necessitated by amendment.
6. Claims 1-6, 8-19 are pending. Claims 1, 8, 11, 12, 13, 14, 15, 16, 17, 18 are independent claims.

***Continued Examination Under 37 CFR 1.114***

7. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/6/2004 has been entered.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-3, 6, 8-10, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliday et al. (hereinafter Halliday), U.S. Patent No. 5,880,740 issued March 9, 1999 in view of Mellgren, III et al. (hereinafter Mellgren), U.S. Patent No. 6,085,126 issued July 2000, and further in view of Cordell et al. (hereinafter Cordell), U.S. Patent No. 5,778,372 issued July 1998 (cited on a previous PTO-892 form).

In regard to independent claim 1, Halliday teaches a workstation, which typically includes a memory (Halliday column 7 lines 5-17, Figure 10; compare with claim 1 "*a memory*").

Halliday teaches use of servers for downloading image information and programs (Halliday Figure 10 items 108, 110, 155, 157, 158). Halliday additionally teaches composite images utilizing HTML from a Web server (said HTML typically interpreted/displayed via a Web browser), and a Netscape Plug-In or downloaded Java applet can be utilized to help interpret/display a document (Halliday column 8 lines 62-67 to column 9 lines 1-13, also column 9 lines 20-27; compare with claim 1 "*a browser to request image information and a display control program from the WWW server and download the image information and the control program*").

Halliday teaches control structures downloaded as a file for creation/manipulation of a composite image on a workstation, images are created in accordance with image identifiers as defined in control blocks within said file, the creation of said images can be accomplished via a downloaded program (Halliday column 4 lines 40-59, column 5 lines 17-27, column 8 lines 29-34, column 9 lines 20-26, also Abstract, Figures 8, 9; compare with claim 1 "*display control means for generating a plurality of control blocks based on the display control*").

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*program which is downloaded by the browser....control blocks developing images in said memory based on the image information which is downloaded by the browser”).*

Halliday does not specifically teach “each” of said control blocks requesting/downloading information from a WWW server. However, Cordell teaches incremental download of pertinent sections of a document, the retrieval occurring only when needed (i.e. as a user causes images to scroll into view on a browser). Each HTML control instruction (i.e. control blocks -HREF statements) assigned to each block of a document is capable of individual activation (Cordell Abstract, column 3 lines 39-67; compare with claim 1 “*each of said control blocks itself having a function of requesting and downloading the image information and the display control program from the WWW server... ”*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Cordell’s prioritization of code blocks to Halliday’s code blocks, image identifiers, etc. resulting in quicker rendition of Halliday’s composite image (see Cordell column 3 lines 60-67).

Halliday teaches display of images and of possible alternative images as defined by a downloaded file as explained above (Halliday column 6 lines 7-11, Figures 1-6, Figure 10 items 121, 137; compare with claim 1 “*display means for displaying an image developed in said memory... ”*).

Halliday teaches an embodiment comprising creation of a greeting card, as well as a digital postcard (Halliday column 3 lines 6-12, Figures 1-6, column 9 lines 55-57). Halliday also teaches said embodiment in the form of a display kiosk (Halliday column 7 lines 23-29). Halliday does not specifically teach said greeting cards/postcards, and kiosk as selections corresponding to a business selected from another displayed image. However, Mellgren teaches a method of customizing imprintable media (i.e. calling cards, etc.) via a commercial kiosk available to consumers (Mellgren column 3 lines 45-51, 60-65). Mellgren teaches a user selecting a type of product (i.e. a list of business related products – stamps, calling cards, etc.) (Mellgren Figure 7), the following screen images are dependent upon user selection of an initial image from Figure 7 (Mellgren Figures 8-11, also column 6 lines 37-52; compare with claim 1 “*... and corresponding to a business which is selected from another image which is being displayed.”*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Mellgren to Halliday’s file embodiment and kiosk, providing

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Halliday the benefit of offering additional material (i.e. business related material) to consumers in a commercial type kiosk environment (see also Mellgren Figures 21-22).

**In regard to dependent claim 2**, claim 2 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Halliday teaches use of a separate Netscape plug-in, as well as a downloadable Java applet for displaying and manipulating images of Halliday's invention (Halliday column 9 lines 7-26).

**In regard to dependent claim 3**, Halliday teaches control IDs identifying images to be displayed, as well as alternate images which can be displayed, or not displayed, depending upon user selection (Halliday Figure 8, 9, column 5 lines 13-28, column 6 lines 7-20).

**In regard to dependent claim 6**, Halliday teaches creation of a composite (i.e. compound) image, which involves sharing of image information (i.e. boundary information) between record identifiers (Halliday Figures 8-9, column 3 lines 6-13, column 4 lines 43-50, also Abstract).

**In regard to independent claim 8**, claim 8 reflects the computer-readable medium for storing computer executable instructions used to implement the methods of the apparatus as claimed in claim 1, and is rejected along the same rationale.

**In regard to dependent claims 9, 10**, claims 9, 10 reflect the computer-readable medium for storing computer executable instructions used to implement the methods of the apparatus as claimed in claims 2, 6, respectively, and are rejected along the same rationale.

**In regard to independent claim 18, claim 18 reflects the method comprising computer readable instructions used in the apparatus as claimed in claim 1, and is rejected along the same rationale.**

**In regard to dependent claim 19, Halliday teaches creation of a composite (i.e. compound) image, which involves sharing of separate image information (i.e. boundary information) between record identifiers (Halliday Figures 8-9, column 3 lines 6-13, column 4 lines 43-50, also Abstract).**

**10. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliday, Mellgren, and Cordell as applied to claim 1, above, and further in view of Bretschneider et al. (hereinafter Bretschneider), U.S. Patent No. 6,128,629 issued October 2000.**

**In regard to dependent claims 4-5, Halliday does not specifically teach timing regarding development and deletion of images. However, Bretschneider teaches a downloadable slide show program with images, said program automatically launched to a viewer which automatically displays a predetermined sequence of images for a predetermined amount of time (images are created and deleted according to a predetermined time) (Bretschneider Abstract, also column 5 lines 54-57; compare with claims 4-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Bretschneider to Halliday's card creation system with kiosk, providing Halliday the benefit of providing timed and periodic demonstrations of its offerings to prospective users.**

**11. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliday in view of Mellgren and Cordell, and further in view of Bretschneider.**

**In regard to independent claim 11**, claim 11 reflects the system comprising computer readable instructions used in the apparatus as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Halliday does not specifically teach timing regarding development and deletion of images. However, Bretschneider teaches a downloadable slide show program with images, said program automatically launched to a viewer which automatically displays a predetermined sequence of images for a predetermined amount of time (images are created and deleted according to a predetermined time) (Bretschneider Abstract, also column 5 lines 54-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Bretschneider to Halliday's card creation system with kiosk, providing Halliday the benefit of providing timed and periodic demonstrations of its offerings to prospective users.

Halliday teaches images either stored on a browser's cache storage area, or downloaded from the Internet, downloading (fetching) when not immediately available (Halliday column 9 lines 30-48; compare with claim 11 "*said output control means causing the WWW client to ... corresponding to the business does not exist in the memory*").

**In regard to independent claim 12**, claim 12 incorporates substantially similar subject matter as claimed in claim 11, and in further view of the following, is rejected along the same rationale.

Halliday teaches image identifiers and control IDs (Halliday column 8 lines 29-35, Figure 8, 9), the system uses said identifiers to check relevant images accordingly (compare with claim 12 "*image check means*", and "*image ID information*").

**In regard to independent claim 13**, claim 13 reflects the apparatus comprising computer readable instructions used to perform the system as claimed in claim 11, and is rejected along the same rationale.



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**In regard to independent claim 14**, claim 14 reflects the computer program product comprising computer readable instructions used to perform the system as claimed in claim 11, and is rejected along the same rationale.

**In regard to independent claim 15**, claim 15 reflects the medium comprising computer readable instructions used to implement the system as claimed in claim 11, and in further view of the following, is rejected along the same rationale.

Halliday teaches image identifiers and control IDs (Halliday column 8 lines 29-35, Figure 8, 9), the system uses said identifiers to check relevant images accordingly (compare with claim 15 “*image check means*”, and “*image ID information*”).

**In regard to independent claim 16**, claim 16 reflects the method comprising computer readable instructions used to perform the system as claimed in claim 11, and is rejected along the same rationale.

**In regard to independent claim 17**, claim 17 reflects the method comprising computer readable instructions used to implement the system as claimed in claim 11, and in further view of the following, is rejected along the same rationale.

Halliday teaches image identifiers and control IDs (Halliday column 8 lines 29-35, Figure 8, 9), the system uses said identifiers to check relevant images accordingly (compare with claim 17 “*in the memory to check...*”, and “*image ID information*”).

*Response to Arguments*

12. Applicant's arguments filed 5/6/2004 have been fully and carefully considered but they are not persuasive.

Applicant argues on pages 14-15 of the amendment that the cited references do not teach each control block requesting data, etc. The examiner respectfully notes that Cordell has been introduced to teach this limitation. Cordell's invention incorporates downloading images of an HTML document only when necessary (i.e. as images scroll into view on a browser), therefore each instruction block (i.e. HREF call) must be capable of separate activation. Cordell's advantage lies in quicker rendering of an HTML document, and shortening download times.

Applicant argues on pages 16-17 of the amendment that the cited references do not teach claims 11, 13, 14, and 16 as currently amended. The examiner respectfully notes that Mellgren teaches a business, and that Halliday teaches storing images in a browser cache, downloading images only when necessary (this teaching is applied to Applicant's currently amended claims). It is respectfully noted that browser caches work by storing previously visited document data. As a user surfs the World Wide Web, document images from said browser cache are often utilized to quicken Web page rendering by lessening server requests.

*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on (703) 305-9792.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703-872-9306)** (for formal/after-final communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Fourth Floor (Receptionist).**



William L. Bashore  
Patent Examiner, AU 2176  
July 10, 2004